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Paper No. 14

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JUN 1.9 1997

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In re Application of Joel A. Ronning Application No. 08/488,195 Filed: June 7, 1995 Attorney Docket No. 10678.1US01

ON PETITION

This letter is in response to your petition filed March 3, 1997 under the provisions of 37 CFR 1.28(c) for the above-identified application.

Two recent district court decisions have considered the practice of submitting a fee deficiency under 37 CFR 1.28(c) and have reached conflicting conclusions. See <a href="https://docs.ncb/>DH Technology v. Synergstex International, Inc.">DH Technology v. Synergstex International, Inc.</a>, 937 F.Supp. 902, 40 USPQ2d 1754 (N.D. Cal. 1996); and <a href="mailto:jewish Hospital of St. Louis v. Idexx Laboratories">Jewish Hospital of St. Louis v. Idexx Laboratories</a>, 951 F.Supp. 1 (D. Me. 1996).

In <u>DH Technology</u>, <u>supra</u>, the District Court for the Northern District of California held that the submission of the balance of the full issue fee under 37 CFR 1.28(c) must also meet the requirements of 37 CFR 1.317. 937 F.Supp., at 909; 40 USPQ2d at 1761. <u>DH Technology</u> is currently under appeal to the Court of Appeals for the Federal Circuit (Federal Circuit).

Since a decision by the Federal Circuit in <u>DH Technology</u> is expected to resolve the conflict concerning 37 CFR 1.28(c), the PTO is holding the acceptance of all submissions of fee deficiencies under 37 CFR 1.28(c) in abeyance pending a decision in <u>DH Technology</u> by the Federal Circuit. See 1198 <u>Official Gazette</u> 27 (May 6, 1997).

Upon a final resolution of the conflict by the Federal Circuit, appropriate action on the petition under 37 CFR 1.28(c) will be undertaken. In the meantime, the file will be held in the Office of Petitions. Additionally, the fees received with the petition will be retained without prejudice to these fees being returned upon final disposition if the petition under 37 CFR 1.28(c) is found unfavorable to applicant. However, if return of these fees is desired before final disposition of the conflict by the Federal

Circuit, a request may be made in writing to the address noted below.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Assistant Commissioner for Patents

Box DAC

Washington, D.C. 20231

By FAX:

(703) 308-6916

Attn: Office of Petitions

By HAND:

One Crystal Park, Suite 520

2011 Crystal Drive Arlington, Virginia

Telephone inquiries concerning this matter may be directed to Robert W. Bahr at (703) 305-9285.

Janice Ford

//Legal Instruments Examiner

Office of Petitions

Office of the Deputy Assistant Commissioner

for Patent Policy and Projects